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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,383	11/04/2003	Jean-Francois Savouret	RICL-110 (69769-011)	5818
35893 7590 09/15/2008 GREENBERG TRAURIG, LLP ONE INTERNATIONAL PLACE, 20th FL. ATTN: PATENT ADMINISTRATOR BOSTON, MA 02110				
EXAMINER				
KEYS, ROSALYND ANN				
ART UNIT		PAPER NUMBER		
1621				
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09/15/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/700,383

**Applicant(s)**

SAVOURET ET AL.

**Examiner**

ROSALYND KEYS

**Art Unit**

1621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9 and 11-32 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 14-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13 and 26-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 9 and 11-32 are pending.  
Claims 11-13 and 26-32 are rejected.  
Claims 9 and 14-25 are withdrawn from consideration.  
Claims 1-8 and 10 are canceled.

### ***Election/Restrictions***

2. Claims 9 and 14-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 2, 2005.
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
  
A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 28 and 31 are rejected under 35 U.S.C. 102(a) as being anticipated by M. Feuerstein et al. (Tetrahedron Letters, Vol. 43, No. 12, March 2002, pp. 2191-2194).

Feuerstein et al. teach the claimed compound of formula I, wherein R3, R5 and R4' are CF3 and R3', R5' and R4 are H (see Scheme 2 on page 2193).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
9. Claims 11-13, 26-29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suga (US 5,530,030) in view of Silverman (The Organic Chemistry of Drug Design and Drug Action, 1992, pp. 15-19), for the reasons given in the previous office action, mailed December 11, 2007.
10. Claims 11-13 and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman (US 6,022,901) in view of Silverman (The Organic Chemistry of Drug Design and Drug Action, 1992, pp. 15-19), for the reasons given in the previous office action, mailed December 11, 2007.
11. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meier et al. (Tetrahedron Letters, Vol. 37, No. 8, February 1, 1996, pp. 1191-1194).

Meier et al. teach a compound which is an adjacent homolog to the compound having the claimed formula I (see pages 1192 and 1193, in particular compounds 9a, 9e, 10a and 10e). When chemical compounds have "very close" structural similarities and similar utilities, without more a prima facie case may be made. See for example In

re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977) (adjacent homologues and structural isomers); In re May, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (stereoisomers); In re Hoch, 428 F.2d 1341, 166 USPQ 406 (CCPA 1970) (acid and ethyl ester). When such "close" structural similarity to prior art compounds is shown, in accordance with these precedents the burden of coming forward shifts to the applicant, and evidence affirmatively supporting unobviousness is required.

#### ***Response to Amendment***

12. The rejection of claim 28 under 35 U.S.C. 102(b) as being anticipated by Meier et al. (Tetrahedron Letters, Vol. 37, No. 8, February 1, 1996, pp. 1191-1194) is withdrawn, due to the amendment to claim 28, which deletes O-C6 alkoxy as a possible substituent for R4'.

#### ***Response to Arguments***

Rejection of claims 28 and 31 under 35 U.S.C. 102(a) as being anticipated by M. Feuerstein et al. (Tetrahedron Letters, Vol. 43, No. 12, March 2002, pp. 2191-2194)

13. Applicant's arguments filed June 11, 2008 have been fully considered but they are not persuasive.

The Applicants submit that Feuerstein's R3 on page 2193 relates to Applicants' R5.

The Examiner disagrees. Feuerstein's R3 on page 2193 relates to Applicants' R4. The Applicants R5 is an H in Feuerstein's compound b. Accordingly claims 28 and 31 are anticipated by Feuerstein.

For the above reasons, this rejection is maintained.

Rejection of claims 11-13, 26-29 and 32 under 35 U.S.C. 103(a) as being unpatentable over Suga (US 5,530,030) in view of Silverman (The Organic Chemistry of Drug Design and Drug Action, 1992, pp. 15-19)

14. Applicant's arguments filed June 11, 2008 have been fully considered but they are not persuasive. Suga teaches a compound which is structurally similar to the claimed compound except that the claims exclude the possibility of when R3 and R5 are Cl that R3' is OH or OCH<sub>3</sub>. The Examiner does not believe that this equates to a teaching away from the claimed invention, especially since all the Applicants have done is substitute a known bioisosteric replacement for the OH and OCH<sub>3</sub> atoms of Suga (see Silverman which teaches that biological properties of homologous compounds show regularities of increase and decrease (see pages 16 and 17) and that OH, F, and Cl are classical isosteres (see Table 2.2 on page 19). One having ordinary skill in the art at the time the invention was made would have found it obvious to interchange F, Cl, or OH with one another or methoxy with ethoxy, as taught by Silverman on the compound of Suga with the expectation of obtaining a compound having similar biological properties.

The claims are therefore considered prima facie obvious and the rejection is maintained.

Rejection of claims 11-13 and 26-32 under 35 U.S.C. 103(a) as being unpatentable over Goodman (US 6,022,901) in view of Silverman (The Organic Chemistry of Drug Design and Drug Action, 1992, pp. 15-19)

15. Applicant's arguments filed October 31, 2007 have been fully considered but they are not persuasive because based upon the teaching of Silverman one having ordinary skill in the art at the time the invention was made would have found it obvious to interchange the OH substituents of Goodman with either a F or a Cl atom with the expectation of obtaining similar biological properties. The combined teaching of Goodman with Silverman does not result in a compound, which teaches away from the claimed invention. The instant claims do not exclude a compound wherein R3, R5 and R3' are each Cl. Nor do the instant claims exclude a compound wherein R3 and R5 are Cl and R3' is F. Such compounds are the result of a combination of Goodman with Silverman.

The claims are therefore considered prima facie obvious and the rejection is maintained.

### **Conclusion**

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROSALYND KEYS whose telephone number is (571)272-0639. The examiner can normally be reached on M, W, F 8 am-3:30 pm; T, Th 5:30 am-7 am & 9:30 am-5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROSALYND KEYS/  
Primary Examiner, Art Unit 1621

September 11, 2008